



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,489	12/04/2000	William Muhammad	9504-001-27	3889

7590 03/06/2003

Supervisor, Patent Prosecution Services
Piper Marbury Rudnick & Wolfe LLP
1200 Nineteenth Street, N.W.
Washington, DC 20036-2412

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,489

Applicant(s)

MUHAMMAD, WILLIAM

Examiner

Mary Cheung

Art Unit

3621

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/2/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4 and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie, U. S. Patent 6,343,738.

As to claim 1, Ogilvie teaches a method for distributing intellectual property comprising the step of (abstract):

- a) Accepting identification information of intellectual property being offered for sale from a seller, the intellectual property being stored on a seller computer associated with seller (column 12 lines 14-23 and column 20 lines 24-30 and column 24 line 66 – column 25 line 11 and Figs. 5, 12);
- b) Storing the identification information in a database of intellectual property being offered for sale (Figs. 5, 12);
- c) Providing access to the database to a user (column 24 lines 56-65 and column 25 lines 51-57 and Fig. 12);
- d) Accepting a designation of desired intellectual property from the user (Fig. 8);
- e) Brokering a payment transaction between the user and the seller (Figs. 6-7);

f) Instructing the seller computer to transfer the intellectual property to the user (column 12 lines 2-7).

As to claim 3, Ogilvie teaches the database is stored on a single server (Fig. 12).

As to claim 4, verifying that intellectual property chosen by the user is available before performing the brokering step is taught by Ogilvie as the intellectual property chosen by the user is transferred to the broker before performing the brokering step (Figs. 5).

Claims 22, Ogilvie teaches the database is stored on a computer used by the purchaser (Figs. 1-2, 5).

Claims 23, Ogilvie teaches the database is stored on the seller's computer (Figs. 1-2).

Claims 21, 24 and 25 are rejected for the similar reason as claims 1 and 4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738 in view of Roberts et al., U. S. Patent 6,292,788.

As to claim 2, Ogilvie teaches providing an agreement under which intellectual property may be distributed to the seller (column 12 lines 47-50 and column 13 lines 61-67); accepting the agreement from the seller (column 12 lines 47-50 and column 13

Art Unit: 3621

lines 61-67); and requiring the user to accept the agreement prior to performing the instruction step (column 12 lines 47-50 and column 13 lines 61-67).

Ogilvie does not explicitly state that there is plurality of agreements that provided to the seller so that the seller can select one the plurality of agreements. Roberts teaches agreements may be varied according to the needs of the clients (column 8 lines 29-54). It would have been obvious to one of ordinary skill in the art to allow Roberts to include plurality of agreements for better suit the needs of the client. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ogilvie to includes plurality of agreements so that the seller can select the best agreement to better meet his/her condition of sales.

5. Claims 5-14, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738 in view of Walker et al., U. S. Patent 6,240,396.

As to claim 5, Ogilvie teaches a system for distributing intellectual property, the system comprising the step of (abstract):

- a) A central server, the central server including a database of intellectual property being offered for sale, the intellectual property being stored on a plurality of seller computer (Figs. 5, 12);
- b) A plurality of buyer's computers are connected to the central server, each of the buyer's computer being configured to perform the step of (Figs. 5-8, 11):

- i) Displaying a list of the intellectual property being offered for sale to a user is taught by Ogilvie as displaying samples of the intellectual property being offered for sale to a user (Figs. 5-9);
- ii) Accepting a selection of intellectual property from the user (Figs. 5-8);
- iii) Transmitting payment information to the central server (Figs. 5-7);
- iv) Receiving intellectual property corresponding to the selection from the seller computer (column 12 lines 2-7 and Fig. 8);
- v) Making the received intellectual property available to the user (Figs. 5-8).

Ogilvie does not explicitly states that the plurality of buyer's computers is plurality of kiosks. Walker teaches that the remote user terminals connected to the central server are kiosks (column 3 lines 45-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the buyer's computers of Ogilvie to be kiosks because it would attract large number of potential buyers to purchase intellectual property via limited number of kiosks.

As to claim 6, Ogilvie teaches the making step is performed by displaying the received intellectual property on a monitor (column 9 lines 16-19).

As to claim 7, Ogilvie teaches the making step is performed by storing the received intellectual property on a storage medium (column 9 lines 10-13).

As to claim 8-12, Ogilvie teaches the storage medium is a compact disk, a DVD, a floppy disk, paper (non-digital goods) and videotape (column 1 lines 20-25 and column 9 lines 35-38 and column 11 lines 2-10).

As to claim 13, Ogilvie teaches the payment information is a credit card number (column 1 lines 54-55).

As to claim 14, the kiosks comprises card reader for reading the credit number is taught by Ogilvie modified by Walker as the kiosk comprises means for processing credit card transaction (Ogilvie: column 9 line 61 – column 10 line 2; Walker: Fig. 1).

As to claims 16 and 18, Ogilvie teaches the central server includes a database of terms under which the intellectual property is being offered (column 12 lines 47-50 and column 13 lines 61-67 and Fig. 12).

As to claim 20, Ogilvie modified by Walker teaches the kiosk is implemented on a single computer (Ogilvie: Fig. 12; Walker: Fig. 1).

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738 in view of Walker et al., U. S. Patent 6,240,396 in further view of Logan et al., U. S. Patent 5,781,909.

As to claim 15, Ogilvie modified by Walker teaches the central server including the database as discussed above. Ogilvie modified by Walker does not specifically teach the central server is configured to transmit a copy of the database to the kiosks and the kiosks are configured to maintain a local copy of the database. However, Logan teaches transmitting documents from a supervisory computer to a remote location so that the local computer maintains a local copy of the documents (title and column 1 line 66 – column 2 line 23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the kiosks (remote user terminals) to maintain a copy of the information from the central server because it would allow

Art Unit: 3621

users to fast access the information via the kiosks, and also to relief the burden of the central server.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738 in view of Walker et al., U. S. Patent 6,240,396 in further view of Roberts et al., U. S. Patent 6,292,788.

As to claim 17, Ogilvie modified by Walker teaches the central server includes terms under which the intellectual property is being offered as discussed above. Ogilvie modified by Walker does not specifically teach the terms correspond to terms selected by a seller from a plurality of standard terms presented to the seller. Roberts teaches there is plurality of terms of agreement, and it may be varied according to the needs of the clients (column 8 lines 29-54 and Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ogilvie modified by Walker to includes plurality of terms of agreement so that the seller can select the best terms to better meet his/her condition of sales.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738 in view of Walker et al., U. S. Patent 6,240,396 in further view of Matsumori, U. S. Patent 6,179,206.

As to claim 19, Ogilvie modified by Walker teaches selling intellectual property via the kiosk as discussed above. Ogilvie modified by Walker does not specifically teach the kiosk is configured to cache frequently purchased items. Matsumori teaches kiosk/computer system to cache frequency purchased items (column 1 lines 32-59). It would have been obvious to one of ordinary skill in the art at the time the invention was

Art Unit: 3621

made to allow the kiosk of Ogilvie modified by Walker to includes the feature of caching frequently purchased items for better advertising/selling products.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hartley-Urquhart (U. S. Patent 6,167,385) discloses financing a supply of goods from a supplier to a buyer in which the buyer has a lower cost of funds than the supplier.

Collart (U. S. Patent 6,453,420) discloses tracking the distribution of content electronically, and the electronic storage medium may be identified using the tracking identifier on the electronic storage medium in order to afford authorized use of the information contained on the electronic storage medium.

Jain et al. (U. S. Patent 6,343,278) discloses improved multiple order facility for a computerized trading system in which a first trader submits a plurality of orders for display and acceptance by other traders, including a first subsystem which permits the first trader to simultaneously generate a plurality of orders, and a second subsystem which displays the orders at computer terminals of the other traders to whom the orders were sent.

Tozzoli et al. (WO 96/12242) discloses a system stores criteria specified by a funder relating to trade transaction for buyers and sellers.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687 (Official Communications; including After Final
Communications labeled "BOX AF")
(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Mary Cheung
Patent Examiner
Art Unit 3621
February 25, 2003